



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,242	06/06/2006	Yoshio Asakura	9369-119US U01-191290C/KK	4058
570 7590 03/30/2009 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			EXAMINER NUTTER, NATHAN M	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 03/30/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,242	Applicant(s) ASAKURA ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-40 and 42-57 is/are pending in the application.
- 4a) Of the above claim(s) 34-40, 42, 53 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-52 and 55-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01-07-09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election without traverse of Group I, claims 21-31 in the reply filed on 2 March 2009 is acknowledged. Applicant has replaced these claims with claims 43-52 and 55-57.

Applicants request the rejoinder of claims 53 and 54 to Group I, claims 43-52 and 55-57. This will not be done since the addition of the resins recited in claim 53 would materially change the properties and composition as recited. The claims belong to non-elected Group II. The Group I and Group II inventions are each rubber blends that may be different in scope and content, and are, thus, not related.

Response to Amendment

In response to the amendment filed 2 March 2009, the following is placed in effect.

The objection to the disclosure is hereby expressly withdrawn.

The rejection of claims 21-31 under 35 U.S.C. 112, first paragraph, for enablement, as set out in the previous Office Action, is hereby expressly withdrawn.

The rejection of claims 21-31 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is modified below, due to the amendment.

The rejection of claims 43-52 and 55-57 under 35 U.S.C. 103(a) as being unpatentable over Kawaguchi (JP 05-194658), is hereby expressly withdrawn.

New grounds of rejection follow.

Claim Rejections - 35 USC § 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43-52 and 55-57 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a “vinyl cis polybutadiene rubber (blend) composition,” does not reasonably provide enablement for any type of “polymer compound containing an oxygen bond.” The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make any use the invention commensurate in scope with these claims.

Case law holds that applicant’s specification must be “commensurately enabling [regarding the scope of the claims].” See *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. Appl. Inter. 1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant’s invention. The test for undue experimentation as to whether or not all compounds within the scope of claims 43-52 and 55-57 can be used as claimed and whether claims 43-52 and 55-57 meet the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. Appl. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Upon applying this test to claims 43-52 and 55-57, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claims 43-52 and 55-57 read on any type of “polymer compound containing an oxygen bond” such as

polyepoxides, polyethers, etc. and any other polymer or derivative of a polymer containing an oxygen bond.

(b) There is **no direction or guidance presented** for making “vinyl cis polybutadiene rubber (blend) composition” comprising any type of “polymer compound containing an oxygen bond.”

(c) There is an **absence of working examples** concerning making “vinyl cis polybutadiene rubber (blend) composition” comprising any type of “polymer compound containing an oxygen bond.”

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claims 43-52 and 55-57.

Claim Rejections - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 43-52 and 55-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 43 of “wherein the 1,2-polybutadiene and the polymer substance are dispersed in the cis-polybutadiene rubber as a matrix component of the vinyl-cis-polybutadiene rubber in an adsorbed state, so as to be insoluble in boiling n-hexane,” renders the claims as vague and confusing since the claim fails to recite a known relationship. The recitation is vague as to context of the polymers. It is not clear if

Art Unit: 1796

“the 1,2-polybutadiene and the polymeric substance” are dispersed “as a matrix” or are dispersed in a matrix of vinyl-cis-polybutadiene. Further, it is not clear whether “the 1,2-polybutadiene and the polymeric substance” are “in the absorbed state” or the “vinyl-cis-polybutadiene rubber” is “in an adsorbed state.”

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-52 and 55-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/596,755 (US 2007/0155889) Okamoto et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the rubber composition of the copending application includes all of the

Art Unit: 1796

constituents herein recited and claimed, including the distribution of the short fibers in the matrix. the other polymer substance in the copending application includes the "diene-based rubber other than (a)," claim 1 (lines 11-12).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 2 March 2009 have been fully considered but they are not persuasive.

With regard to the provisional rejection of claims 43-52 and 55-57 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/596,755 (US 2007/0155889) Okamoto et al, no Terminal Disclaimer has been filed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

25 March 2009